

REMARKS

Claims 1, 3-8, 10-12, 14-20, and 22-28 remain pending in this application. Claims 2, 9, 13 and 21 have been canceled, without prejudice. Claims 1, 7, 20 and 25 were amended. No new matter has been introduced as a result of the amendments.

Claims 1, 3-8, 10-12, 14, 15 and 18 stand rejected under 35 U.S.C. §102(e) as being anticipated by *Davis et al.* (U.S. Patent No. 6,282,522).

Claims 25 and 26 have been rejected under 35 U.S.C. §102(b) as being anticipated by *Claus* (U.S. Patent No. 5,461,217).

Claims 2, 9, 13 and 16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Davis et al.* (U.S. Patent No. 6,282,522) in view of *Walker et al.* (US Patent 5,828,751).

Claim 17 has been rejected under 35 U.S.C. §103(a) as being unpatentable over *Davis et al.* (U.S. Patent No. 6,282,522) in view of *Nerlikar* (US Patent 5,629,981).

Claims 19-21 and 24 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Davis et al.* (U.S. Patent No. 6,282,522) in view of *Claus* (U.S. Patent No. 5,461,217).

Claims 22 and 23 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Davis et al.* (U.S. Patent No. 6,282,522) in view of *Claus* (U.S. Patent No. 5,461,217), and further in view of *Nerlikar* (US Patent 5,629,981).

Claim 27 has been rejected under 35 U.S.C. §103(a) as being unpatentable over *Claus* (U.S. Patent No. 5,461,217) in view of *Nerlikar* (US Patent 5,629,981). The Applicants respectfully traverse these rejections. Favorable reconsideration is respectfully requested.

Specifically, *Davis* does not disclose transmitting the contents information access requests and terminal identification information, wherein the second information processing unit collates received terminal identification information and pre-registered terminal identification information, and outputs the contents information readout request to the first information processing unit in the event that the received terminal identification information and pre-registered terminal identification information match, as recited in claims 1 and 7, and similarly recited in claims 13, 14, 19, 20 and 25. *Davis* merely discloses a client terminal 204 that includes a client code module 224 and card reader module 226. The client terminal 204 communicates via client module 224 with a payment server 206 (col. 12, lines 39-50). The communications between a stored-value card and the system are protected via encryption (col.

17, lines 8-11; 27-31), however there is no mention of terminal identification information and pre-registered terminal identification information, wherein a collation process allows for the transmittal of content information.

While *Walker* discloses assigning unique device IDs to devices (col. 4, lines 34-42), there is no teaching suggestion or motivation to combine *Walker* with *Davis*. The same argument applies to *Claus* and *Nerlikar* as well.

Under 35 U.S.C. §103, the following considerations must be made in order to determine obviousness:

- (1) The claimed invention must be considered as a whole;
- (2) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (3) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (4) Reasonable expectation of success is the standard with which obviousness is determined.

(MPEP 2141). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). (MPEP 2142). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratosflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) (MPEP 2141.02). The mere fact that references can be combined or modified

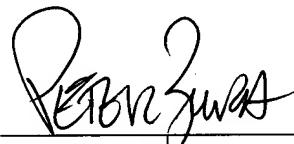
does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (MPEP 2143.01). In other words, the suggestion or desirability to combine reference must come from the references themselves, and not from the applicant's disclosure.

Regarding claim 14, the claim recited that the second information processing unit calls up the communication device. This feature is not taught in *Davis*, nor any of the other cited art.

For at least these reasons, the Applicants submit that the rejections under 35 U.S.C. §102 and §103 are improper and should be withdrawn. An early Notice of Allowance is earnestly requested. If any fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket number (112857-222) on the account statement.

Respectfully submitted,
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Dated: December 23, 2004